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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,957	08/11/2005	David John Hughes	50698	3769
26748 7590 04/09/2009 SYNGENTA CROP PROTECTION, INC. PATENT AND TRADEMARK DEPARTMENT 410 SWING ROAD GREENSBORO, NC 27409				
EXAMINER SZNAIDMAN, MARCOS L				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
04/09/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

department-gso.patent@syngenta.com

### Office Action Summary

**Application No.**

10/517,957

**Applicant(s)**

HUGHES ET AL.

**Examiner**

MARCOS SZNAIDMAN

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to applicant's reply filed on January 29, 2009.

#### ***Status of Claims***

Amendment of claim 8 and cancellation of claim 15 is acknowledged.

Claims 1-14 are currently pending and are the subject of this office action.

Claims 1-7, and 9 were withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 6, 2008.

Due to Applicant's amendment, the previously examined species in the Office Action mailed on August 28, 2008 (1-phenyl-1'-n-propylspiro [indoline-3,4'-piperidine] (CAS# 69620-57-1)) no longer reads on the instant claims, so the current examination was expanded to all the remaining species.

Claims 8 and 10-14 are presently under examination.

#### ***Priority***

The present application is a 371 of PCT/GB03/02424 filed on 06/04/2003, and claims priority to foreign application UNITED KINGDOM 02137 5.6 filed on 06/14/2002.

#### ***Rejections and/or Objections and Response to Arguments***

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated (Maintained Rejections and/or Objections) or newly applied (New Rejections and/or Objections, Necessitated by Amendment or New Rejections and/or Objections not Necessitated by Amendment). They constitute the complete set presently being applied to the instant application.

***Claim Rejections - 35 USC § 103 (New Rejection Necessitated by Amendment)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

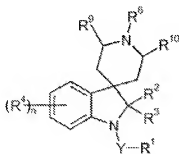
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoechst (GB 1603030, cited in prior Office Action) in view of Bauer et. al. (US 3,959,475).

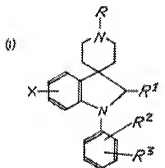
Claims 8 and 11-14 recite a compound of formula IK:



Wherein R<sup>8</sup> is -C(R<sup>51</sup>)(R<sup>52</sup>)-[CR<sup>53</sup>=CR<sup>54</sup>]<sub>z</sub>-R<sup>55</sup> where z is 1 or 2, preferably 1, R<sup>51</sup> and R<sup>52</sup> are each independently H, halo or C1-2 alkyl, R<sup>53</sup> and R<sup>54</sup> are each

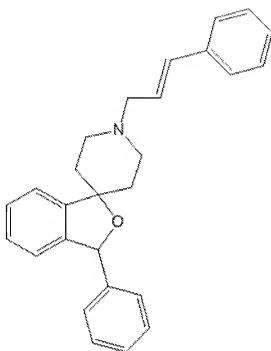
independently H, halogen, C1-4 alkyl or C1-4 haloalkyl and R55 is phenyl substituted by halogen, C1-4 alkyl, or C1-4 alkoxy.

For claims 8 and 11-14 Hoechst teaches compounds of general formula I:

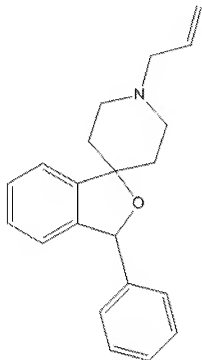


The compounds are useful as antidepressants, anticonvulsants and tranquilizers. R can be for example: "alkenyl" generally (see page 1, lines 10-12), and provides "allyl" as a specific example thereof (see page 7, line 16). The compounds of formula I do not encompass the R substituent:  $-C(R_{51})(R_{52})-[CR_{53}=CR_{54}]_z-R_{55}$  wherein z is 1 or 2, preferably 1, R<sub>51</sub> and R<sub>52</sub> are each independently H, halo or C1-2 alkyl, R<sub>53</sub> and R<sub>54</sub> are each independently H, halogen, C1-4 alkyl or C1-4 haloalkyl and R<sub>55</sub> is phenyl substituted by halogen, C1-4 alkyl, or C1-4 alkoxy.

However Bauer teaches the following compounds:



(See compound 110 on Table VII, columns 17 and 18, in this case the R substituent is phenyl substituted allyl group)



(See compound 105 on Table VII, columns 17 and 18, in this case the R substituent is allyl). These compounds are tranquilizers and antidepressants (see abstract).

Hoechst teaches that the R substituent can be "alkenyl" generally (see page 1, lines 10-12), and provides "allyl" as a specific example thereof (see page 7, line 16). It differs from the instant claims insofar as it does not specifically disclose a phenyl-substituted allyl substituent.

When chemical compounds have "very close" structural similarities and similar utilities, without more a prima facie case may be made. In re Wilder, 563 F.2d 457 (CCPA 1957). Stated alternatively, obviousness may be based solely upon structural



similarity (an established structural relationship between a prior art compound and the claimed compound, as with homologs). See In re Duel, 51 F.3d 1552, 1559 (Fed. Cir. 1995). The necessary motivation to make the claimed compound, and thus the prima facie case of obviousness, arises from the reasonable expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018 (CCPA 1979).

Bauer discloses compounds having the same utility and having the same structural core. As is clear from the disclosure of compounds 105 (R = allyl) and 110 (R = phenyl substituted allyl), these two groups: allyl ( $-\text{CH}_2\text{-CH=CH}_2$ ) and phenyl substituted allyl ( $-\text{CH}_2\text{-CH=CH-Ph}$ ) are functional equivalents for the utility intended.

Accordingly, it would have been obvious to have chosen a phenyl substituted allyl moiety as the "alkenyl" substituent of the primary reference, motivated by the established structural relationship between allyl and phenyl allyl provided by the secondary reference, and given the very close structural similarity of the two moieties.

Claim 10 further limits claim 8, wherein a composition comprises an insecticidally, acaricidally or nematocidally effective amount of: 1-phenyl-1'-n-propylspiro [indoline-3,4'-piperidine] (species examined). According to the specification (see page 90, lines 17-19), an insecticidally, acaricidally or nematocidally effective amount is defined as: a composition that comprises by weight 0.0001% to 95%, more preferably 1% to 85%, for example 5 to 65% of active ingredient.

For claim 10, Hoechst further teaches (see page 7, lines 31-39) that these compounds can be part of a composition or preparation further comprising diluents,

carriers, etc.; and that the preparations should contain at least 0.5% of active compound, which anticipates the 0.0001% to 95% by weight concentration of the instant application.

The statement in claim 10: "an insecticidal, acaricidal or nematocidal" is considered an intended use and does not add any new limitation to the claim. *Catalina Mktg. Int'l, Inc. V. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (fed. Cir. 2002). "The recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

### ***Withdrawn Rejections and/or Objections***

#### ***Claims rejected under 35 USC 102.***

Due to Applicant's amendments the 35 USC 102 rejection is now moot.

Rejection under 35 USC 102 is withdrawn.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARCOS SZNAIDMAN** whose telephone number is (571)270-3498. The examiner can normally be reached on **Monday through Thursday 8 AM to 6 PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571 272-0580. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARCOS SZNAIDMAN/  
Examiner, Art Unit 1612  
March 23, 2009.

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612